

REMARKS/ARGUMENTS

Reconsideration of this application is requested. Claims 35, 37 and 38 are in the case.

I. CLAIM OBJECTIONS

Claims 35-36 are objected to because they identify their status as "currently amended". In response, now that amendments are presented to claim 35, that claim is designated as "currently amended". Claim 36 is canceled without prejudice, and is designated as "canceled". Withdrawal of the claim objections is respectfully requested.

II. PRIORITY

The Action alleges that disclosure of the prior-filed applications, Application No. PCT/U598/05072 (filed March 17, 1998) and US Provisional Application No. 60/040,858, fail to provide adequate support or enablement in the manner provided by the first paragraph of 35 §U.S.C. 112 for one or more claims of the present application. In view of this interpretation, certain prior art rejection are raised which are discussed below.

In response to the priority objection, and without conceding thereto, claim 35 has been amended to remove the language "the precursor is not hydroxybutyryl carnitine". Further, claim 35 has been amended to recite a limited number of species for the term metabolic precursor that were previously recited in claim 36, with the exception of the free fatty acid species.

Support for these amendments is found in the originally filed application as follows:

- (i) medium chain length triglycerides: paragraph [0044] as published;
- (ii) esters of D- β -hydroxybutyric acid or its oligomers with monohydric, dihydric or trihydric alcohols or acetoacetate: paragraph [0087] as published;
- (iii) wherein the monohydric, dihydric or trihydric alcohols in (iii) and (iv) are selected from the group C1-C4 alkyl alcohols, (R)-1,3-butandiol and glycerol: paragraph [0093] as published.

Withdrawal of the priority objection is respectfully requested.

III. SPECIFICATION

The disclosure is objected to because the term "C₁₄ alkyl esters" disclosed at "page 23, line 9" (it is believed "page 26, line 7" was intended as there is no such language at page 23, line 9) is allegedly difficult to read and has been interpreted by the USPTO printing department as "C₁₄ alkyl esters". A similar clarity issue is present at page 26, line 7.

In response, the specification has been amended at those two locations to clarify the portions of the disclosure objected to in the Action. Withdrawal of the objections to the specification is respectfully requested.

IV. THE FORMAL REJECTIONS

Claims 35-39 are rejected under 35 U.S.C. §112, second paragraph, as allegedly indefinite because claim 36 recites "free fatty acids, the metabolism of which is through - oxidation". In response, and without conceding to this rejection, claim 36 has been canceled without prejudice.

Claim 35 as amended without prejudice does not refer to free fatty acids. However, Applicant maintains the wording "medium chain triglycerides" as possessing plain meaning in the art, in other words as representing the group of glycerides that are glycerol esters of medium chain fatty acids of from six to twelve carbon atoms. This is evidenced by the PDR for Nutritional Supplements 2nd Edition (2008) pages 416 to 419 (copy submitted by way of an IDS herewith). This reference further discloses documents that predate the present application, including Bach and Babayan; The American Journal of Clinical Nutrition 36: (1982) (copy also included in the accompanying IDS). Both clearly disclose that medium chain triglycerides are of C₆ to C₁₂ chain length. The reference to margarine and heavy cream in the present specification should not be used to limit the plain meaning of the term "medium chain triglycerides".

Claim 36 is rejected under 35 U.S.C. §112, first paragraph, as allegedly not in compliance with the written description requirement. Without conceding to this rejection, claim 36 has been canceled without prejudice. Withdrawal of the formal rejections is respectfully requested.

V. THE ANTICIPATION REJECTIONS

Claims 35-39 are rejected under 35 U.S.C. §102(e) as allegedly anticipated by Martin *et al.* (US 6,380,244 B2) (Martin). Claim 36 is rejected under 35 U.S.C. §102(b) as allegedly anticipated by Martin. Claim 36 is rejected under 35 U.S.C. §102(b) as allegedly anticipated by Veech (US 6,207,856 B1).

As claim 36 has been canceled without prejudice, the anticipation rejections of that claim have been rendered moot. With the amendment to remove the reference to hydroxybutyryl carnitine, the claims are entitled to a date which is earlier than the effective dates of the cited references. Withdrawal of the anticipation rejections over Martin and Veech is respectfully requested.

Favorable action is awaited.

Respectfully submitted,

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